REMARKS

Claims 1-13 were pending in this application. In the Restriction requirement dated November 17, 2000 (Paper No. 5), the Examiner has required restriction of the claims to one of seven inventions. In response, Applicants hereby provisionally elect, with traverse, to prosecute the claims of Group I (Claims 1-5) drawn to a method for treating a cancer comprising administering a compound). Claims 6-13, drawn to non-elected subject matter, have been canceled, without prejudice to Applicants' right to pursue the subject matter of the canceled claims in future applications. Claims 1-5 are, therefore, pending in the instant application. A courtesy copy of the pending claims is included herewith as Exhibit A.

With respect to Examiner's division of the invention into seven groups and the reasons stated therefor, Applicants respectfully traverse. The Examiner contends that each group of claims is directed to an invention that is distinct from the other. This contention has two bases. First, the Examiner contends that the allegedly different inventions are distinct methods that differ in the method objectives, method steps and parameters and reagents used. Furthermore, the Examiner contends that the allegedly different classification of the seven different groups justifies the restriction requirement (Restriction Requirement, page 3). Applicants respectfully submit that the classification as presently set forth in the Restriction Requirement would not justify a restriction requirement between the first two groups of the seven aforementioned Groups.

Specifically, the Examiner asserts that the claims of Group I (claims 1-5) are drawn to a method for treating a cancer comprising administering a compound, classified in class 435, subclass 6 and that the claims of Group II (claims 1-5) are drawn to a method for treating a cancer comprising administering a compound, classified in class 435, subclass 27;

Applicants respectfully submit that Class 435 is entitled "Molecular Biology and Microbiology." Subclass 27 is entitled "Involving catalase". Subclass 27 is indented under subclass 25 which is itself entitled "Subject matter where the material to be measured or tested contains catalase or the agent used for the measurement or test contains catalase".

Applicants respectfully submit that the use of a ribozyme as noted in the Examiner's description of Group II does not involve catalase. Thus, in the absence of the

correct classification for the searching of claims directed to a method for treating a cancer comprising administering a compound wherein that compound is a ribozyme, Applicants respectfully submit that the subject matters of the claims divided by the Examiner into Groups I and II do not justify a restriction requirement into the two afore-mentioned groups, based on the reasons set forth by the Examiner.

The M.P.E.P. § 803 states:

If the search and examination of an entire application can be made without serious burden, the examiner >must< examine it on the merits, even though it includes claims to distinct or independent inventions (emphasis added).

Thus, in view of M.P.E.P. § 803, Applicant respectfully submits that all the subject matter in Groups I and II should be examined together. Even if the subject matter of these groups are distinct inventions, it would not be a "serious burden" on the Examiner to search these groups in this application. Indeed, as Applicant has explained above, the burden of searching these two groups together would be no greater than that for Group I alone.

In view of the above remarks, it is believed that the undersigned has shown that the inventions of Groups I and II are not distinct as required by MPEP § 803. Thus, Applicants has demonstrated at the very least that the subject matter of the claims of Groups I and II should be examined in the same application. Applicants respectfully request, therefore, that the restriction requirement be modified so as to combine restriction Groups I and II and further, that all of Claims 1-5 be searched and examined together with respect to the stated compound being either an antisense molecule or a ribozyme molecule.

In order to be fully responsive, however, Applicants hereby provisionally elect the claims of Group I (Claims 1-5) in accordance with 37 C.F.R. § 1.143. Applicants also hereby provisionally elect melanoma as the specific cancer to be examined. Applicants reserves the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Entry of the remarks made herein is respectfully requested.

Respectfully submitted,

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Enclosures

APPENDIX

PENDING CLAIMS

U.S. PATENT APPLICATION NO. 09/305,084, DOCKET NO. 5914-080 (As Amended Under 37.C.F.R. §1.143 on December 13, 2000)

1. A method for treating a cancer, comprising administering a compound that is an antagonist to an endothelin B receptor (ETB) to a subject in need of such treatment.

2. The method of Claim 1 in which the cancer is selected from the group consisting of melanoma, prostate cancer, colon cancer, ovarian cancer or mammary cancer.

3. The method of Claim 2 in which the cancer is melanoma.

4. The method of Claim 1, in which the compound is a mimic of Endothelin-1.

5. The method of Claim 1 in which the compound is an antisense or ribozyme molecule that blocks translation of a molecule that activates ETB.